

REMARKS

Applicant respectfully requests further examination and reconsideration in view of the arguments set forth fully below. Claims 1-44 were previously pending in this Application. Within the Office Action, Claims 1-44 have been rejected. Accordingly, Claims 1-44 remain pending in the application.

Claim Rejection - 35 U.S.C. § 103

Claims 1-44 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Howard et al. (U.S. Patent Application Publication No. 2004/0103064) in view of Hori et al. (U.S. Patent Application Publication No. 2004/0010467).

For a §103 obviousness rejection to be proper, the burden of establishing that all elements of the invention are disclosed in the prior art must be met; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. MPEP 2143.

Claim 1 recites a method of downloading content from a server to an electronic device, comprising: storing authentication data on a removable memory, wherein the authentication data includes a predetermined level of content access; accessing the server with the electronic device; authenticating the removable memory by reading the authentication data from the removable memory to determine the predetermined level of content access; and downloading the content from the server to the removable memory according to the predetermined level of content access.

Howard is directed to a model relating to the payment for online content. Specifically, Howard teaches access is automatically granted to online content when the smart card is inserted into a reader attached to the user's PC, and cut off when the smart card is removed from the reader. [Howard, Abstract] However, Howard fails to disclose content being downloaded from a server to a removable memory. Howard merely discloses transferring content from a content server to a user PC (Paragraph 0025). Accordingly, Howard does not teach the presently claimed invention.

Hori is directed to a memory card that includes a memory to store encrypted content data. [Hori, Abstract] Specifically, Hori teaches a memory card receives the encrypted content data and license through cellular phone 100 and applies decryption on the above encryption, and then provides the decrypted data to the music reproduction unit in the cellular phone. [Hori, 0065]

Hori is only cited for the purpose of teaching content being downloaded from a server to a removable memory.

On Pages 7 and 8 of the Office Action dated February 18, 2009, it is recognized that Howard “fails to disclose downloading the content from the server to the removable memory.” Instead, it is asserted that Hori discloses downloading content from the server to the removable memory and that it would have been obvious to one of ordinary skill in the art to have incorporated this feature of Hori’s invention within Howard to include downloading the content from the server to the removable memory. Within the Office Action, it is argued that the motivation would be “to prevent distributed copyrighted data from being replicated without permission of the copyright owner.”

Applicant respectfully disagrees with this assertion. The invention of Howard operates under the principle that the content is downloaded to the user PC, not the removable memory (Paragraph 0025). Modifying the invention of Howard to download the content to the removable memory instead of the user PC would change its principle operation. According to MPEP 2143.01(VI), if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Therefore, since the proposed modification would change the principle of operation of Howard, Applicant respectfully submits that the teachings of the prior art references are not sufficient to render the claims *prima facie* obvious.

Furthermore, the alleged motivation is nonexistent because there is no indication in Hori that downloading the content to the removable memory instead of the user PC would, on its own, prevent distributed copyrighted data from being replicated without permission of the copyright owner. On the contrary, it appears that this prevention of impermissible replication relies on the entirety of the invention of Hori, including a complex data storage structure that comprises a plurality of authentication data hold means, a select means, a key hold means, a first decryption means, a session key generation means, a session key encryption means, and a session key decryption means. Modifying Howard to include all of these features would significantly, unnecessarily, and undesirably complicate and increase the cost of the invention of Howard. In other words, even if Howard downloaded the content to the removable memory instead of the PC (as taught by Hori), Howard would be no more protected from copyright violations. Both methods of storage are equally susceptible to copyright infringement. As a result, Howard would not be motivation to incorporate Hori as it would not provide any benefit (i.e. no increased copyright protection) while instead increasing complexity. Accordingly, the combination of

Howard and Hori is improper because there is no motivation for their combination.

Additionally, since it is unclear which elements of Hori are believed to be necessary to prevent distributed copyrighted data from being replicated without permission of the copyright owner, Applicant respectfully requests that the specific features of Hori be identified which should be incorporated into Howard for the asserted motivation of preventing impermissible replication. As stated above, Applicant believes that Hori's prevention of impermissible replication relies on factors other than downloading of the content to the removable memory. Thus, if all that is incorporated from Hori into Howard is the downloading to removable memory, it will not result in the prevention of the replication of copyrighted data, and thus the proposed motivation is not actually present.

Within the Office Action of October 1, 2009, it is asserted that “[i]n response to the applicant’s argument that ‘it is unclear which elements of Hori are believed to be necessary to prevent distributed copyrighted data from being replicated without permission of the copyright owner’ ... the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.” [Office Action, page 4] However, this response in no way addresses the questions raised by the Applicant. Firstly, the Applicant did not describe “another advantage” that would flow from following the prior art, instead the Applicant described the alleged motivation for combining Hori with Howard cited within the Office Action. Thus, the above response is a mischaracterization of the Applicants assertions and thus unrelated to the issue. Secondly, the actual issues presented were unaddressed by the response.

Specifically, the Applicant reiterates the request that the specific features of Hori that are necessary to prevent the replication of copyrighted data (as asserted as motivation in the Office Action) be identified. Indeed, this identification is necessary because, depending on the features necessary, the combination of Hori and Howard is likely improper as it would alter the primary purpose/operation of Howard. Further, as described above, if the only feature to be incorporated is the “downloading to removable memory”, it is clear from Hori that more is required to effectuate the prevention of copyrighted material replication, and thus asserted motivation for combination is nonexistent. Accordingly, the Applicant respectfully requests that the specific features of Hori be identified which should be incorporated into Howard for the prevention of copyrighted data replication.

Unlike Howard, Hori and their combination, the presently claimed invention is directed to a method of and system for authorization and authentication downloading utilizes a removable memory having a set of authentication data. A user accesses a server with a handheld electronic

device via a wireless Internet connection. The removable memory includes the set of authentication data. The handheld electronic device includes an interface to connect to the Internet when the removable memory is inserted into the handheld electronic device and a connection is formed with a server, using the set of authentication data, the server is able to authenticate the removable memory automatically without the user interfacing personally with the server. The server authenticates downloading to the removable memory in the handheld electronic device by reading the set of authentication data on the removable memory, and downloading the desired content to the removable memory. As described above, the combination of Howard and Hori is improper. Accordingly, neither Howard, Hori nor their combination teach the presently claimed invention.

The independent Claim 1 is directed to a method of downloading content from a server to an electronic device. The method of Claim 1 comprises storing authentication data on a removable memory, wherein the authentication data includes a predetermined level of content access, accessing the server with the electronic device, authenticating the removable memory by reading the authentication data from the removable memory to determine the predetermined level of content access and downloading the content from the server to the removable memory according to the predetermined level of content access. As described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 1 is allowable over the teachings of Howard, Hori and their combination.

Claims 2-9 are dependent on the independent Claim 1. As described above, the independent Claim 1 is allowable over the teachings of Howard, Hori and their combination. Accordingly, Claims 2-9 are all also allowable as being dependent on an allowable base claim.

The independent Claim 10 is directed to a system for downloading content from a server to an electronic device. The system of Claim 10 comprises means for storing authentication data on a removable memory, wherein the authentication data includes a predetermined level of content access, further wherein the authentication data is preinstalled on the removable memory, means for receiving the removable memory in the electronic device, means for accessing the server with the electronic device, means for authenticating the removable memory by reading the authentication data from the removable memory to determine the predetermined level of content access and means for downloading the content from the server to the removable memory according to the predetermined level of content access. As described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 10 is allowable over the teachings of Howard, Hori and their combination.

Claims 11-18 are dependent on the independent Claim 10. As described above, the independent Claim 10 is allowable over the teachings of Howard, Hori and their combination. Accordingly, Claims 11-18 are all also allowable as being dependent on an allowable base claim.

The independent Claim 19 is directed to a system for downloading content. The system of Claim 19 comprises a removable memory, the removable memory including authentication data, the authentication data including a predetermined level of content access, an electronic device configured to receive the removable memory and a server, wherein when the electronic device accesses the server, the removable memory is authenticated by reading the authentication data from the removable memory and determining the predetermined level of content access, and further wherein once authenticated, content according to the predetermined level of content access is downloaded from the server to the removable memory. As described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 19 is allowable over the teachings of Howard, Hori and their combination.

Claims 20-27 are dependent on the independent Claim 19. As described above, the independent Claim 19 is allowable over the teachings of Howard, Hori and their combination. Accordingly, Claims 20-27 are all also allowable as being dependent on an allowable base claim.

The independent Claim 28 is directed to an electronic device for downloading. The device of Claim 28 comprises a memory slot configured to receive a removable memory, wherein the removable memory includes authentication data, the authentication data including a predetermined level of content access and a communications interface configured for coupling to a server, wherein when the electronic device accesses the server through the communications interface, the removable memory is authenticated by reading the authentication data from the removable memory to determine the predetermined level of content access, further wherein content according to the predetermined level of content access is downloaded to the removable memory. As described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 28 is allowable over the teachings of Howard, Hori and their combination.

Claims 29-35 are dependent on the independent Claim 28. As described above, the independent Claim 28 is allowable over the teachings of Howard, Hori and their combination. Accordingly, Claims 29-35 are all also allowable as being dependent on an allowable base claim.

The independent Claim 36 is directed to a removable memory for downloading. The removable memory of Claim 36 comprises authentication data, the authentication data including a predetermined level of content access and a communications interface configured for coupling to a server, wherein when an electronic device accesses the server through the communications

interface, the removable memory is authenticated by reading the authentication data from the removable memory to determine the predetermined level of content access, further wherein the electronic device includes a memory slot configured to receive the removable memory, and further wherein content according to the predetermined level of content access is downloaded to the removable memory, further wherein the predetermined level of content access determines how much of the content on the server is available for download. As described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 36 is allowable over the teachings of Howard, Hori and their combination.

Claims 37-43 are dependent on the independent Claim 36. As described above, the independent Claim 36 is allowable over the teachings of Howard, Hori and their combination. Accordingly, Claims 37-43 are all also allowable as being dependent on an allowable base claim.

The independent Claim 44 is directed to a method of downloading content from a server to an electronic device. The method of Claim 44 comprises storing authentication data on a removable memory, wherein the authentication data includes a predetermined level of content access, accessing the server with the electronic device, authenticating the removable memory by reading the authentication data from the removable memory to determine the predetermined level of content access and automatically downloading the content from the server to the removable memory according to the predetermined level of content access, wherein the authentication data is time stamped, such that the predetermined level of content access is available for a predetermined amount of time. As described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 44 is allowable over the teachings of Howard, Hori and their combination.

For the reasons given above, the applicant respectfully submits that the claims are now in a condition for allowance, and allowance at an early date would be appreciated. Should the Examiner have any questions or comments, they are encouraged to call the undersigned at (408) 530-9700 to discuss the same so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,
HAVERSTOCK & OWENS LLP

Dated: November 30, 2009 By: /Jonathan O. Owens/

Jonathan O. Owens
Reg. No. 37,902
Attorneys for Applicant(s)